

**Application No.: 09/998,693**

**Amendments to the Drawings**

Figs. 9-11 have been amended to include "Prior Art" label, as attached, in response to the Examiner's objection to these drawings.

Attachment: Replacement Sheet

## REMARKS

### **I. Introduction**

Claims 1-10 are pending in this Application. In this Amendment, claim 10 has been amended only to improve wording, but the scope of the claim is not narrowed for any reason relating to patentability. Care has been exercised to avoid the introduction of new matter.

### **II. Objection to the Drawings**

The Examiner has suggested that Figs. 9-11 should be amended to include the legend "Prior Art." In response, Figs. 9-11 have been amended in a manner suggested by the Examiner. Withdrawal of the objection to the drawings is respectfully solicited.

### **III. The Rejection of Claims 10 under 35 U.S.C. §102(e)**

In the statement of the rejection, the Examiner asserted that Williams discloses a controller identically corresponding to what is claimed. This rejection is respectfully traversed.

It is well established precedent that the factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of the claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *See EMI Group N. Am., Inc. v. Cypress Semiconductor Corp.*, 268 F.3d 1342, 60 USPQ2d 1423 (Fed. Cir. 2001); *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F. 3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994).

Applicants submit that Williams does not disclose a multi-initiator control method in which packet-unit communication is performed with each of a plurality of devices, as is recited by claim 10.

Williams discloses a controller for controlling execution of commands by receiving the commands sent from one initiator (host 36 in Fig. 9) to generate linked data transfer descriptors (DTDs) (see, column 6, lines 24-42). Since interrupts to a processor are decreased, command overhead can be reduced. The linked DTDs, which reduce a command overhead, can be generated in the case where multiple commands are sent from a single initiator. However, Williams does not disclose controlling a plurality of initiators, as claimed.

It is noted that Williams discloses “there can be multiple initiators” in column 1, line 22. However, this sentence merely describes, that the SCSI standard allows a bus to be connected to multiple initiators. Williams fails to disclose how to handle commands received from a plurality of initiators.

In contrast, claim 10 recites “determining whether or not receipt of a command fetch request from one of the plurality of devices is stored,” “fetching a command from the one of the plurality of devices...,” and “one of the plurality of device is selected in a predetermined order...” (emphasis added), which distinguishes the claim over Williams.

The above-described fundamental differences between the claimed invention and Williams undermine the factual determination that Williams identically describes the claimed invention within the meaning 35 U.S.C. §102. Applicants, therefore, submit that the imposed rejection of claim 10 under 35 U.S.C. §102(e) for lack of novelty as evidenced by Williams is not factually viable and, hence, respectfully solicit withdrawal thereof.

**IV. The Rejection of Claims 1-4 and 6-9 under 35 U.S.C. §103(a)**

In the statement of the rejection, the Examiner asserted that it would have been obvious to modify Applicants' admitted prior art ("AAPA") based on the teachings of Williams to arrive at the claimed invention. This rejection is respectfully traversed.

Applicants submit that the Examiner has not established a *prima facie* basis to deny patentability to the claimed invention under 35 U.S.C. §103 for lack of the requisite factual basis. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

AAPA and Williams, either in combination or individually, do not teach or suggest a multi-initiator control unit including all the limitations recited in independent claim 1. Specifically, the applied combination does not teach or suggest, at minimum, a multi-initiator control unit in which packet-unit communication is performed with each of a plurality of devices. Moreover, the proposed combination does not teach or suggest a plurality of command control circuits each for controlling a command processing sequence performed with the corresponding device. In contrast, in the claimed invention, even when receiving commands from multiple devices (initiators), the claimed multi-initiator control unit can appropriately deal with the commands.

As admitted by the Examiner, AAPA does not teach that the control unit disclosed thereby is a multi-initiator control unit. For the reasons set forth above with respect to the rejection of claim 10, Williams fails to teach a multi-initiator control unit in which a plurality of initiators perform packet-unit communication. Further, Williams does not teach a multiple initiator control unit which includes a plurality of command control circuits, each corresponding to one of multiple initiators.

Accordingly, AAPA and Williams, either in combination or individually, do not teach or suggest a multi-initiator control unit including all the limitations recited in independent claim 1 within the meaning of 35 U.S.C. §103.

Applicants further submit that there is no motivation to modify AAPA based on Williams. To establish the requisite motivation to support a finding of obviousness under 35 U.S.C. §103, “clear and particular” factual findings must be made as to a specific understanding or specific technological principle that would have realistically compelled one having ordinary skill in the art to modify a particular reference to arrive at the claimed invention based upon facts-- not generalizations. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 57 USPQ2d 1161 (Fed. Cir. 2000); *Ecolchem Inc. v. Southern California Edison, Co.*, *supra*; *In re Kotzab*, 217 F.3d 1365, 55 USPQ 1313 (Fed. Cir. 2000); *In re Dembiczak*, *supra*. Such motivation, must be based upon “clear and particular” showings of combinability in the prior art -- not in the application disclosure. *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985).

The Examiner asserted that AAPA can be modified because there is motivation “to allow multiple commands sent by multiple initiators to be stored and subsequently processed in an efficient manner” (the first full paragraph on page 6 of the Office Action) (emphasis added).

However, there is no motivation to modify AAPA to arrive at the claimed invention because there is no teaching or support of allowing “multiple commands sent by multiple initiators to be stored and subsequently processed in an efficient manner” in the applied combination of the reference. Moreover, the object of Williams is to deal with the commands sent from the single initiator, whereas the claimed invention is to deal with the commands sent from multiple devices (see, page 9, line 24 to page 10, line 1 of the specification). Accordingly,

there is no evidentiary basis for modification of AAPA to arrive at the claimed invention. The applied combination does not teach handling multiple commands from multiple initiators.

Based upon the foregoing, Applicants submit that the Examiner has not established a *prima facie* basis to deny patentability to the claimed invention in independent claim 1 for lack of the requisite factual basis and want of the requisite realistic motivation. Dependent claims 2-4 and 6-9 are also patentably distinguishable over AAPA and Williams at least because they respectively include all the limitations recited in independent claim 1. Applicants, therefore, submit that the imposed rejection of claims 1-4 and 6-9 under 35 U.S.C. §103 for obviousness predicated upon AAPA in view of Williams is not factually or legally viable and, hence, respectfully solicit withdrawal thereof.

**V. The Rejection of Claim 5 under 35 U.S.C. §103(a)**

In the statement of the rejection, the Examiner asserted that claim 5 would have been obvious over AAPA in view of Williams, and further in view of Bashford et al.

In response, it is submitted that the applied combination of the references does not teach or suggest a multiple-initiator control unit including all the limitation recited in claim 5, at least because the claim includes all the limitations recited in independent claim 1. Applicants emphasize that Bashford et al. does not teach or suggest a multi-initiator control unit in which packet-unit communication is performed with each of a plurality of devices (initiators). Withdrawal of the rejection of claim 5 under 35 U.S.C. §103 is respectfully solicited.

**VI. Conclusion**

It should, therefore, be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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